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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,913	04/21/1999	HOWARD B. SOSIN	2001611-0008	7739

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EXAMINER

CRAIG, DWIN M

ART UNIT	PAPER NUMBER
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2123

12

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/295,913

Applicant(s)

SOSIN, HOWARD B.

Examiner

Dwin M Craig

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/25/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 25-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 19 and 23 is/are rejected.
- 7) ☒ Claim(s) 2-4, 6-18, 20-22 and 24-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2123

### DETAILED ACTION

1. Claims 1-24 are presented for reconsideration in view of Applicant's arguments and amended claim language dated 11-13-2003 (*see paper # 11*). Claims 1-24 have been elected and Claims 25-45 have been cancelled. Claims 1-24 have been allowed over the prior art of record.

#### Election/Restrictions

2. Applicant has elected Claims 1-24 and cancelled Claims 25-45.

#### Specification

3. Applicant has amended the specification on page 1 and the Examiner withdraws any objections to the specification.

#### Response to Arguments

4. Applicant's arguments filed on 11-13-2003 have been fully considered and are persuasive.

##### 4.1 Regarding the 35 U.S.C. 103(a) rejections of Independent Claim 1:

Applicant argued:

Applicant can find no teaching in the highlighted sections of the *Wood* reference (nor in any other section) that relate to a step of "determining a perceived force function relating perceived force to club length and club head mass for the golfer" as required in the second step of claim 1. (*See page 9 of 12 of paper # 12*).

The Examiner asserts that prior art of record is deficient in that the cited references do not contain the limitations cited in Applicant's arguments. The Examiner withdraws the earlier 35 U.S.C. 103(a) rejections of independent Claim 1.

##### 4.2 Regarding the 35 U.S.C. 103(a) rejections of Claim 23:

Applicants have argued:

Art Unit: 2123

The Examiner does not point to any teachings in Wood that relate to Any steps of Claim 23, namely of (1) having the golfer swing a test club to determine its perceived length; (2) having the golfer swing a comparison club one or more times while adding weight to the comparison club as a selected point along the shaft until the golfer is unable to distinguish the perceived lengths of the test club and the comparison club; and (3) determining the center point around which the test club and the weighted comparison club have identical radii of gyration. *(See pages 11 of 12 and 12 of 12 of paper # 12).*

The Examiner asserts that the prior art of record is deficient in not teaching, disclosing or making obvious the limitations as argued by the Applicant and finds Applicant's arguments to be persuasive. The earlier 35 U.S.C. 103 rejections of independent Claim 23 are withdrawn.

The Examiner has reviewed the prior art of record, specifically the references provided with the Applicant's IDS.

**Claim Rejections - 35 USC § 102**

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**5. Independent Claims 1, 5 and 19 rejected under 35 U.S.C. 102(e) as being clearly anticipated by WOOD, PCT/US98/02240.**

**5.1** As regards independent Claims 1, 5, 9 and 23 the *Wood* reference teaches, a method of designing a customized golf club (**page 3 lines 1-18**), determining a tempo function (**page 35 lines 11-27**), relating tempo to club length (**page 4 lines 6-26**), for a particular golfer (**page 3 lines 4-8 and page 13 lines 5-7**), shaft flexibility of the club (**page 4 lines 29-32**), preferred trajectory for a golf ball (**page 12 lines 15-18**), club head mass (**page 14 lines 21-23**), and perceived force functions (**page 26 lines 22-28**).

Art Unit: 2123

5.2 As regards independent **Claim 23** limitation of having the golfer swing a test golf club (page 5 line 5-6).

**Allowable Subject Matter**

6. **Claims 2-4, 6-18, 20-22 and 24** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

7. This action is **NON-FINAL**. Claims 25-45 are cancelled. Claims 1-25 have been elected. Claims 1, 5, 19 and 23 are rejected. Claims 2-4, 6-18, 20-22 and 24 are objected to.

7.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. **U.S. Patent 6,328,660** discloses a method for fitting a golf club to a particular golfer.
2. **U.S. Patent 4,889,575** discloses a method of manufacturing golf club shafts.

7.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwin M Craig whose telephone number is 703 305-7150. The examiner can normally be reached on 9:00 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 703 305-9704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of

Art Unit: 2123

a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

DMC

February 8, 2004



KEVIN J. TESKA  
SUPERVISORY  
PATENT EXAMINER